

## **REMARKS/ARGUMENTS**

In the Office Action dated July 17, 2006, Claims 1-11 and 13-24 were rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter. Also, Claims 1-24 were rejected under 35 U.S.C. §112, paragraph 1. Further, Claims 1 and 13 were rejected under 35 U.S.C. §112, paragraph 2. Additionally, Claims 1-24 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application No. 2003/0110504 A1 to *Plourde et al.* ("*Plourde*") in view of U.S. Patent No. 6,205,525 to *Korst* ("*Korst*").

Reconsideration of this application is respectfully requested in view of the attached claim amendments and the following remarks.

### **Claim Rejections**

#### **35 U.S.C. §101 Rejections**

In the Office Action, Claims 1-11 and 13-24 were rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter. Independent Claims 1 and 13 have been amended to include a rendering element, thereby producing a useful, concrete and tangible result.

In the Office Action, Claims 13-24 were also rejected under 35 U.S.C. §101, as being directed to non-statutory subject matter. Applicants are unaware of any precedent that would indicate that signals are non-statutory subject matter. Quite the contrary. In Appeal No. 2,002-1554 in the case of *Ex parte Rice* (Application 08/003,996) the BPAI reversed an examiner's rejection of signal claims as being directed to non-statutory subject matter under 35 U.S.C. § 101, holding that electromagnetic signals, although "transitory and ephemeral in nature," are statutory subject matter. Accordingly, Applicants respectfully submit that, as amended, Claims 1 and 13, and their dependent claims, are now in condition for allowance.

#### **35 U.S.C. §112 Rejections**

In the Office Action, Claims 1 and 13 were rejected under 35 U.S.C. §112, first and second paragraphs. Claims 1 and 13 have been amended to obviate these

rejections. Applicants respectfully submit that the amended Claims 1 and 13, and their dependent claims, are now in condition for allowance.

#### Claims 12 and 24

Applicants graciously acknowledge the Examiner's indication that Claims 12 and 24 would be allowable if rewritten in independent form. Applicants respectfully note that given the allowability of their respective amended base claims, such an amendment is unnecessary at this time.

### **35 U.S.C. §103 Rejections**

#### Claims 1 and 13

*Plourde* discloses a Digital Video Recorder system that allows storing of subscriber television content. *Korst* discloses a video on demand system that retrieves stored content and streams it to a user device. Neither *Plourde* nor *Korst*, alone, or in combination, teach or suggest a method of storing streamed presentation data within a container file that includes a virtual file for each of one or more presentation sources. In contrast, amended Claim 1 reads as follows:

1. A method of storing streamed presentation data within a container file, the method comprising:
  - receiving one or more data streams from each of one or more presentation sources within the presentation;
  - creating within the container file, a virtual file for each of the one or more presentation sources;
  - temporarily storing first data associated with a first data stream of a first presentation source in association with a first virtual file corresponding to the presentation source;
  - determining a container file size;
  - temporarily storing additional data from the first data stream in place of at least a portion of the first data if the container file size is within a predetermined range of an identified maximum buffer size; and
  - rendering at least one of said one or more data streams.

(emphasis added)

The provision of a virtual file for each of the one or more presentation sources recited in Claim 1 provides a level of flexibility that is not needed, nor taught or suggested by either *Plourde* or *Korst*. A method as recited in Claim 1 is not limited to by the lack of virtual files within a container as taught by *Plourde* (*Korst* fails to teach any alternative). In addition, as the Examiner is well aware, the determination of the obviousness of an invention requires consideration of the claimed invention as a whole, not merely the differences between the claimed invention and the prior art. *Lear Sigler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025 (Fed. Cir. 1984). Thus, each and every recitation in a claim must be considered in the context of the claimed invention as a whole, not as a collection of individual recitations. Accordingly, for this reason, with regard to Claim 1, it is abundantly clear that Claim 1 is not anticipated by *Plourde* and/or *Korst*.

Additionally, in the Office Action, it is correctly recognized that *Plourde* does not teach or suggest determining a container files size. However, the Office Action stated that *Plourde* combined with the teaching of *Korst* would remedy this deficiency. Applicants beg to differ. Nowhere in *Korst*, let alone in the cited section (col. 7, lines 17-23) is there a teaching of “determining a container file size.” *Korst* only “determines how many data streams are active at the moment” and “calculates the size of the data block to be read.” Neither determining how many streams are active nor calculating the size of data blocks to be read have any bearing on determining a container file size that is used to store one or more virtual files corresponding to one or more presentation sources as recited in Claim 1.

Accordingly, amended Claim 1 (and corresponding machine readable medium Claim 13) and all the rejected claims dependent therefrom (Claims 2-11 and 14-23) are clearly allowable.

#### Claims 2-11 and 14-23

Claims 1 and 13 are allowable as noted above. Additionally, dependent Claims 2-11 and 14-23 are allowable as they depend from allowable claims. These claims include further recitations not taught, disclosed, or even suggested by

*Plourde* and/or *Korst*. A nonexclusive listing of some reasons Claims 2-11 and 14-23 are allowable are included below.

For example, Claims 3 and 15 recite “storing second data associated with a second data stream of the first presentation source in association with the first virtual file.” *Plourde* does not even mention any reference to virtual files. *Plourde* merely cites a conventional FAT storage system with convention separate files on a storage medium. In particular, *Plourde* (and *Korst*) fail to teach or suggest storing a presentation that can contain multiple sources within a single container file as one or more virtual files. For these reasons, in addition to those already noted above, Claims 3 and 15 and their dependent claims are in condition for allowance.

In another example, Claims 9 and 21 include “a first data block; and a file descriptor block containing at least a seek index and a seek index granularity, wherein the seek index indicates a plurality of equally distributed data blocks within the corresponding virtual file and the granularity indicates a size for each of the data blocks.” *Plourde* and *Korst* also fails to teach and/or suggest such a seek index, let alone a seek index that indicates a plurality of equally distributed data blocks within the corresponding virtual file. The portions of *Plourde* that were cited as teaching a seek block (paragraphs 88 and 110) do not mention seek indexes, let alone a seek index as recited in Claim 9. *Plourde* merely states “The type of media content (e.g. westerns, comedies, action, etc) can be presented to the user (for selection, or user configurable without a pre-configured list), and then a preference filter can seek and effect the receipt of such content for contemporaneous and/or later viewing.” It is clear that *Plourde*’s mere mention of the word “seek” is not sufficient a teaching to render Claim 9 obvious. For this reason as well, in addition to those already noted above, Claims 9 and 21 and their dependent claims are in condition for allowance.

#### Relevant Case Law Regarding Asserted 35 U.S.C. §103(a) Rejections

Furthermore, in each of the 35 U.S.C. §103(a) rejections discussed above and asserted in the Office Action, the Examiner has attempted to use the pending application to define the problem to be solved by reference to different elements from the prior art. The Federal Circuit has clearly indicated that any attempt to

selectively cull from the prior art to fit a claimed invention is prohibited. In this regard, the Examiner's attention is directed to the following decisions of the Federal Circuit:

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed invention as a whole, we infer that the Board used hindsight to conclude that the invention was obvious...To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. *In re Kahn*, 441 F.3d 977, 78 U.S.P.Q.2d 1329 (2006).

[D]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patent invention. There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements and to combine them as combined by the inventor. *Crown Operations Intern., Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (2002).

Although the suggestion to combine references may flow from the nature of the problem, defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. Therefore, when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the

desirability and thus the obviousness, of making the combination'...We cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (2000). (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist*, 730 F.2d 1452, 221 U.S.P.Q. 481 (1984)). (Emphasis added).

Obviousness may not be established using hindsight. In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *Kahn v. General Motors Corp.*, 135 F.3d 1472, 45 U.S.P.Q.2d 1608 (1998).

It is impermissible...to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious. *In re Gorman*, 993 F.2d 982, 18 U.S.P.Q.2d 1885 (1991).

In reviewing the decisions of the Board which are based on...obviousness grounds, our focus must be whether "the differences between the subject matter sought to be patented and the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made." *In re Kaslow*, 707 F.2d 1366, 217 U.S.P.Q. 1089 (1983).

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of amended Claims 1 and 13. In addition, Applicants suggest that Claims 2-11 and 14-23, which depend directly or indirectly on Claims 1, and 13, are patentably distinct over the combination of *Plourde* in view of *Korst*.

## CONCLUSION

Applicants submit that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this application to issue is respectfully requested. The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

Respectfully submitted,  
AXIOS LAW GROUP

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